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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
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09/423,100	12/11/2000	Zhong-Ru Gan	20700-703	6340
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20350 7590 09/25/2002

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EXAMINER

NICHOLS, CHRISTOPHER J

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 09/25/2002

*N*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/423,100

Applicant(s)

GAN, ZHONG-RU

Examiner

Christopher Nichols, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 28 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 78-130 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 78-130 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.
2. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.
3. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-102, 104-108, 111-113, 116-127, and 129 (each in part) drawn to a method for preparing a bioactive protein comprising expressing a recombinant protein comprising a first peptidyl fragment and a second peptidyl fragment wherein the first peptidyl fragment mediates formation of the bioactive conformation of the second peptidyl fragment wherein the first peptidyl fragment comprising SEQ ID NO: 1 and the second peptidyl fragment comprises SEQ ID NO: 4.

Group II, claim(s) 1-102, 104-107, 109, 111-112, 114, 116-127, and 129 (each in part) drawn to a method for preparing a bioactive protein comprising expressing a recombinant protein comprising a first peptidyl fragment and a second peptidyl fragment wherein the first peptidyl fragment mediates formation of the bioactive conformation of the second peptidyl fragment wherein the first peptidyl fragment comprising SEQ ID NO: 2 and the second peptidyl fragment comprises SEQ ID NO: 4.

Group III, claim(s) 1-102, 104-107, 110-112, 115-127, and 129 (each in part) drawn to a method for preparing a bioactive protein comprising expressing a recombinant protein comprising a first peptidyl fragment and a second peptidyl fragment wherein the first peptidyl fragment mediates formation of the bioactive conformation of the second peptidyl fragment wherein the first peptidyl fragment comprising SEQ ID NO: 3 and the second peptidyl fragment comprises SEQ ID NO: 4.

Group IV, claim(s) 1-101, 103-108, 111-113, 116-126, and 128-129 (each in part) drawn to a method for preparing a bioactive protein comprising expressing a recombinant protein comprising a first peptidyl fragment and a second peptidyl fragment wherein the first peptidyl fragment mediates formation of the bioactive conformation of the second peptidyl fragment wherein the first peptidyl fragment comprising SEQ ID NO: 1 and the second peptidyl fragment comprises SEQ ID NO: 5.

Group V, claim(s) 1-101, 103-107, 109, 111-112, 114, 116-126, and 128-129 (each in part) drawn to a method for preparing a bioactive protein comprising expressing a recombinant protein comprising a first peptidyl fragment and a second peptidyl fragment wherein the first peptidyl fragment mediates formation of the bioactive conformation of the second peptidyl fragment

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wherein the first peptidyl fragment comprising SEQ ID NO: 2 and the second peptidyl fragment comprises SEQ ID NO: 5.

Group VI, claim(s) 1-101, 103-107, 110-112, 115-126, and 128-129 (each in part) drawn to a method for preparing a bioactive protein comprising expressing a recombinant protein comprising a first peptidyl fragment and a second peptidyl fragment wherein the first peptidyl fragment mediates formation of the bioactive conformation of the second peptidyl fragment wherein the first peptidyl fragment comprising SEQ ID NO: 3 and the second peptidyl fragment comprises SEQ ID NO: 5.

Group VII, claim(s) 130, drawn to an assay for improving bioactive conformation mediation activity comprising determining a yield for the step of causing the second peptidyl fragment of the second recombinant protein to adopt the bioactive conformation.

4. The inventions listed as Groups I, II, III, IV, V, VI, and VII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

5. Group I recites the technical feature of SEQ ID NO: 1 meditating the formation of SEQ ID NO: 4, which is not required by the other Groups II, III, IV, V, VI, or VII.

6. Group II recites the technical feature of SEQ ID NO: 2 meditating the formation of SEQ ID NO: 4, which is not required by the other Groups I, III, IV, V, VI, or VII.

7. Group III recites the technical feature of SEQ ID NO: 3 meditating the formation of SEQ ID NO: 4, which is not required by the other Groups I, II, IV, V, VI, or VII.

8. Group IV recites the technical feature of SEQ ID NO: 1 meditating the formation of SEQ ID NO: 5, which is not required by the other Groups I, II, III, V, VI, or VII.

9. Group V recites the technical feature of SEQ ID NO: 2 meditating the formation of SEQ ID NO: 5, which is not required by the other Groups I, II, III, IV, VI, or VII.

10. Group VI recites the technical feature of SEQ ID NO: 3 meditating the formation of SEQ ID NO: 5, which is not required by the other Groups I, II, III, V, or VII.

11. Group VII recites the technical feature of determining a yield, which is not required by the other Groups I, II, III, V, VI, or VII.

12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher James Nichols, Ph.D. whose telephone number is (703) 305-3955. The examiner can normally be reached on Monday through Friday, 8:30AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, Ph.D. can be reached on 703-308-4623. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9307 for After Final communications. The fax phone numbers for the customer service center is 703-872-9305.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

CJN  
September 24, 2002

  
**GARY KUNZ**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**